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|---|-------------|-----------------------------|---------------------|------------------|
| 10/783,235 | 02/20/2004 | Dean F. Jerding | A-9764 | 7398 |
| 5642 7590 10/02/2008 SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044 | | | | |
| EXAMINER PENG, FRED H | | | | |
| ART UNIT 2623 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

Office Action Summary

Application No.

10/783,235

Applicant(s)

JERDING ET AL.

Examiner

FRED PENG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 05/27/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., options of providing functionality that enables termination of an IPG) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Based on the broadest and reasonable interpretations, the Applicant's emphasized features of "one of options that is configured to terminate provision of an interactive program guide (IPG)" can be interpreted as "options to terminate a specific function or feature within the IPG instead of terminating the IPG itself"; hence the teaching of Alexander with option to unlock the lock function of video display in the IPG reads into the Applicant's claimed features.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al (US 6,177,931).

Regarding Claims 1 and 5, Alexander discloses a television set-top terminal (STT) (Col 3 lines 21-25) with corresponding method configured to output video signals to a television, the STT comprising:

- at least one tuner configured to receive video signals corresponding to video presentations (Col 4 lines 5-8; cable box for receiving television programs inherently includes at least one tuner);

- memory having stored therein program code (inherent with television cable box); and at least one processor that is programmed by the program code (Col 5 lines 21-53) to enable the STT to:

- provide a user with a menu that includes a plurality of options corresponding to respective control settings for controlling functionality of a channel navigation key (FIG.4A, FIG.4B; options of lock or unlock channel navigation key to tune and display video for selected channel at PIP Window), wherein the menu is displayed via the television (display on top of TV screen); receive a first user input corresponding to one of the plurality of options that is configured to terminate provision of an interactive program guide (IPG) having a plurality of television program listings (FIG.4B; select unlock button terminates lock state and entering unlock state);

- provide the IPG (FIG.4B; providing program guide information);

- receiving a second user input corresponding to the channel navigation key (navigate guide with up or down arrow keys and display corresponding video image in PIP Window); and

- responsive to receiving the second user input and responsive to having previously received the first user input (enter select button for highlighted desired broadcast channel):

- terminate providing of the IPG (exit program guide after entering select button for highlighted desired broadcast channel); and

- provide a video presentation (display last selected program; Col 3 line 63 – Col 4 line 27).

Regarding Claims 2, 4, 6 and 8, Alexander further discloses a video display area is provided in conjunction with the IPG, and wherein the video presentation that is provided

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responsive to receiving the second user input is different from a video presentation that is displayed in the video display area immediately prior to receiving the second user input (Col 4 lines 8-10).

Regarding Claims 3 and 7, Alexander discloses a television set-top terminal (STT) (Col 3 lines 21-25) with corresponding method configured to output video signals to a television, the STT comprising:

- at least one tuner configured to receive video signals corresponding to video presentations (Col 4 lines 5-8; cable box for receiving television programs inherently includes at least one tuner);

- memory having stored therein program code (inherent with television cable box); and at least one processor that is programmed by the program code (Col 5 lines 21-53) to enable the STT to:

- provide a user with a menu that includes a plurality of options corresponding to respective control settings for controlling functionality of numerical input keys (FIG.4A, FIG.4B; options of lock or unlock numerical input keys to tune and display video for selected channel at PIP Window), wherein the menu is displayed via the television (display on top of TV screen);
 - receive a first user input corresponding to one of the plurality of options that is configured to terminate provision of an interactive program guide (IPG) having a plurality of television program listings (FIG.4B; select unlock button terminates lock state and entering unlock state);

- provide the IPG (FIG.4B; providing program guide information);

- receiving a second user input corresponding to at least one of the numerical input keys (Col 16 lines 28-35; navigate guide with numerical keys and display corresponding video image in PIP Window); and

- responsive to receiving the second user input and responsive to having previously received the first user input:

terminate provision of the IPG (IPG stays in unlock state); and provide a video presentation (display last selected program; Col 3 line 63 – Col 4 line 27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:00-18:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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